



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/031,764	09/30/2002	Bansi Lal	HMR99L044/PCT/US	8326
5487	7590	10/19/2005	EXAMINER	
ROSS J. OEHLER AVENTIS PHARMACEUTICALS INC. ROUTE 202-206 MAIL CODE: D303A BRIDGEWATER, NJ 08807			AUDET, MAURY A	
			ART UNIT	PAPER NUMBER
			1654	
DATE MAILED: 10/19/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/031,764

Applicant(s)

LAL ET AL.

Examiner

Maury Audet

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 August 2005.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9 and 10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,6,7,9 and 10 is/are rejected.
- 7) ☒ Claim(s) 4 and 5 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The rejection of claims 1-3, 6-7, and 9-10 under 35 U.S.C. 102(b) as being anticipated by either Balkovec et al. I (US 5,378,804; also cited within Applicant's PCT/EP00/06769 Form 409 as Document 4 (D4), under it's WO continuity WO-A-9421677) or Balkovec et al. II (US 5,541,160; also cited within Applicant's PCT/EP00/06769 Form 409 as Document 1 (D1), under it's WO continuity WO-A-9527074), are maintained for the reasons of record. Applicant's arguments have been considered, but are not persuasive. The core peptide is known, and as to these claims, the references still teach each and every limitation (more specifically, some or all of the various R groups, in some instances due to Applicant's alternative claim language; for instance, R8 and R9 are still taught since "H" alone may still be so attached (rather than just the alternative secondary amine structure, which Applicant's argument focused primarily on)).

Claim Rejections - 35 USC § 103

The rejection of claims 1-3, 6-7, and 9-10 under 35 U.S.C. 103(a) as being unpatentable over either Balkovec et al. I (US 5,378,804; also cited within Applicant's PCT/EP00/06769 Form 409 as Document 4 (D4), under it's WO continuity WO-A-9421677) or Balkovec et al. II (US 5,541,160; also cited within Applicant's PCT/EP00/06769 Form 409 as Document 1 (D1), under it's WO continuity WO-A-9527074), is maintained for the reasons of record. Applicant's arguments have been considered, but are not persuasive. The rejections are maintained for the same reasons discussed above.

Art Unit: 1654

Objection and Indication of Allowable Subject Matter

Claims 4 and 5, if amended to include all the limitations of the base claims from which they depend, would likely receive favorable consideration. In consideration of Applicant's arguments and further review of the prior art of record, positions R8 and R9 are not reasonably taught or suggested by the prior art of record to contain the secondary amine structure of claims 4-5. However, since these dependent claims depend from rejected base claims, they are presently objected to. [Likewise, if the composition of claim 7, and methods of making of claims 9-10 were so amended, the subject matter of these claims would also likely receive favorable consideration].

Conclusion

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maury Audet whose telephone number is 571-272-0960. The examiner can normally be reached from 7:00 AM – 5:30 PM, off Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached at 571-272-0974. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197.

MA, 10/15/2005



CHRISTOPHER R. TATE
PRIMARY EXAMINER